

REMARKS

In addition to electing the species encompassed by claim 20, Applicants are required to identify claims readable on the elected species. As recognized by the Examiner, claims 12-19, and claims 22-23 are generic and are all readable on claim 20.

With that said, reconsideration and withdrawal of the Examiner's requirement for restriction and election of species is respectfully requested. Applicants respectfully traverse this restriction requirement for the following reasons.

Restriction may be required if two or more "independent and distinct" inventions are claimed in one application. 35 U.S.C. § 121; 37 C.F.R. § 1.141. However, Applicants respectfully submit that the main purpose of Rule 141 is to facilitate the search in considering the patentability of the claimed subject matter and to avoid a situation that requires separate and diverse searches to be conducted on claims directed to independent (unrelated) subject matter. Inventions are deemed "independent" if there is no disclosed relationship and/or if the inventions are unconnected in design, operation or effect. See M.P.E.P. § 802.01.

The Patent Office practice as set forth in the MPEP requires that search and examination of the entire application must impose a serious burden on the Examiner before a proper requirement for restriction may be made. MPEP 803, page 800-4, col. 1 (third paragraph in MPEP 803). Thus, the Patent Office encourages the assertion that examination of the entire application may take place where such search and examination

can be made without serious burden, even though separate, non-overlapping searches may be required.

The Examiner has not asserted that the allergens to which claims 12-19, and 22-23 are applicable are not so linked as to form a single general inventive concept. Applicants respectfully disagree that the Examiner has met the conditions for a proper restriction requirement.

In the present situation, the restriction requirement is deficient in that a showing has not been made that the alleged non-generic claims 20 and 21 are directed to independent inventions, or that they define such species of the alleged generic claims 12-19, 22-23, that impose serious burden on searches and examination. In fact, were the Examiner to combine dependent claim 20 with independent claim 12, Applicants believe that no new classification in the art would be created relative to the Examination of claim 12 standing alone. The same is true of the other alleged generic claims as well, because generic claims 12 – 19, 22-23, define a patentable method of treating or preventing an allergic disorder to which the allergens of dependent claims 20 and 21 are particularly applicable. Specifically, the search and examination of this patent so touches and concerns method claims 12-19, 22-23, that the particular allergen involved is such a collateral issue that Applicants do not believe impose additional burdens on the Examination process.

Accordingly, Applicants submit that since the examiner has not shown the existence of separate classification, or separate status in the art, or a different field of

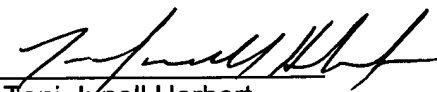
In re Application of: Mahler et al.
Serial No.: 10/026,931
Attorney Docket: 966927-00007
(Old S&H Docket No. 0273-0007)

search under MPEP 808.02, the Examiner has not made a prima-facie showing of a serious burden and it is, therefore, incumbent upon the Examiner to conduct such a search. Applicants respectfully request that the Examiner reconsider and withdraw this restriction requirement.

This response being due on July 07, 2004, Applicants believe that a one month extension of time is necessary. Such an extension is hereby requested by the filing of the accompanying petition and the petition fee. However, in the event that additional extensions of time are necessary to prevent the abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 50-0622.

Respectfully submitted,

REED SMITH LLP

By: 
Toni-Junell Herbert
Reg. No. 34,348

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Reed Smith LLP
1301 K Street, N.W.
Suite 1100- East Tower
Washington, DC, 20005-3373.